

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Olli-Pekka Pohjola et al.

Title: SECURE UPSTREAM
TRANSMISSION IN PASSIVE
OPTICAL NETWORKS

Appl. No.: 10/717,601

Filing Date: 11/21/2003

Patent No.: 7,593,638

Grant Date: 9/22/2009

Examiner: Hanh Phan

Art Unit: 2613

Confirmation 8207

Number:

**RENEWED REQUEST FOR RECONSIDERATION OF PATENT TERM
ADJUSTMENT UNDER 37 C.F.R. §1.705**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully renew their request for reconsideration of the Patent Term Adjustment (PTA) determined for the captioned patent which issued on 9/22/2009 as U.S. Patent No. 7,593,638. The USPTO indicated in the letter mailed August 6, 2009 (copy attached as Exhibit A), that a decision on the Applicants' initial request was dismissed as premature.

The Patent Office determined that the patent was entitled to 604 days of PTA. Applicants believe that this PTA determination was made in accordance with the "Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. §154(b)(2)(A)" published at 69 Fed. Reg. 34238 (Jun. 21, 2004). Under that interpretation of the PTA statute, any PTO delay under 35 U.S.C. § 154(b)(1)(A) is deemed to overlap with any 3-

year maximum pendency delay under 35 U.S.C. § 154(b)(1)(B), and so, as a practical effect, PTA may be awarded under §154(b)(1)(A) or §154(b)(1)(B), but not both.

On September 30, 2008, the United States District Court for the District of Columbia issued a decision finding that the U.S. Patent and Trademark Office's interpretation of the PTA statute is incorrect. *Wyeth v. Dudas*, Civ. Action No. 07-1492 (JR) (Sep. 30, 2008). The court determined that, under the correct interpretation of the PTA statute, periods of "overlap" are limited to "periods of time . . . [that] occur on the same day." *Wyeth*, slip op. at 8. Thus, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays "occur on the same day." *Id.*

Applicants have recalculated PTA for the captioned patent under the court's interpretation of the PTA statute, and have determined that the patent is entitled to 1103 days PTA, as shown on the attached sheet (Exhibit B), which shows the relevant delays under 37 CFR §§1.702(a) and (b), and under 37 CFR §§1.703(a) and (b).

The attached sheet details the circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

(a) Total of non-overlapping PTO delay under §154(b)(1)(A) & (B): 1193 days

(b) Total Applicant delay: 90 days

Final PTA Determination: 1103 days

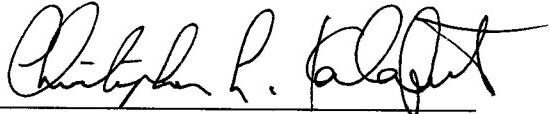
Applicants therefore respectfully request that the patent be accorded 1103 days PTA.

The patent is not subject to a terminal disclaimer.

Because this is a renewed request, Applicants do not believe that any fee is due, the fee having been paid with the Applicants' original request on March 10, 2009. However, if a fee is due, and should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

Applicants request further that a decision on this request be deferred or delayed until a final decision has been rendered in *Wyeth v. Dudas*, which is now on appeal at the U.S. Court of Appeals for the Federal Circuit, under Federal Circuit Docket No. 2009-1120.

Respectfully submitted,

By 

Date November 19, 2009

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EXHIBIT A

AUG 06 2009

OFFICE OF PETITIONS

In re Application of :
Pohjola et al. :
Application No. 10/717,601 : ON APPLICATION FOR
Filed: November 21, 2003 : PATENT TERM ADJUSTMENT
Atty Docket No. 088245-2354 :

This is in response to the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705 filed March 10, 2009. Applicant submits that the patent term adjustment to be indicated on the patent is one thousand twenty-nine (1029) days, not five hundred thirty (530) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicant requests this correction solely on the basis that the Office will take in excess of three years to issue this patent¹.

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of

¹ Applicants take into consideration that a request for continued examination (RCE) was filed in this application on April 3, 2008. An RCE cuts-off their ability to accumulate any additional patent term for over three year pendency. The 1.702(b) period excludes any period consumed by continued examination requested by applicant under 35 U.S.C. 132(b).

issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee².

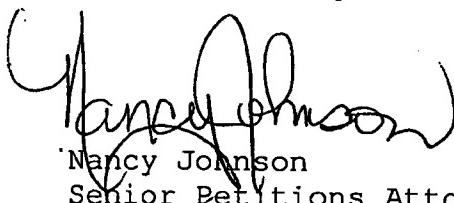
The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

² For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3219.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Patent Term Adjustment Calculation System

Add a new event to this case

Docket Number:088245-2354
Application Number:10/717601
Patent Number:N/A

EXHIBIT B

	Event Description	Event Date	Days from Filing	PTO Days	Applicant Days
Edit Delete	Application Filing Date	11/21/2003	0		
	14 month From Application date	01/21/2005	427		
CLOSE WINDOW	All Cases - SELECT CASE Non-Final Office Action	10/03/2006	1,047	620	
	3 Year Period Starts	11/21/2006	1,096		
	Non-Final Office Action + 3 months	01/03/2007	1,139		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	02/05/2007	1,172		33
Edit Delete	IDS under 1.704(c)(8) filed at PTO	03/06/2007	1,201		29
Edit Delete	Non-Final Office Action	05/17/2007	1,273		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	08/17/2007	1,365		
Edit Delete	Notice of Allowance	10/09/2007	1,418		
Edit Delete	Issue Fee Paid	01/08/2008	1,509		
Edit Delete	Request for Withdrawal from Issuance	04/03/2008	1,595		
Edit Delete	Request For Continued Examination (including amendment)	04/03/2008	1,595	499	
	3 Year Period Stopped	04/03/2008	1,595		
Edit Delete	Withdrawn from Issuance by PTO	04/04/2008	1,596		
Edit Delete	Non-Final Office Action	06/18/2008	1,671		
	Non-Final Office Action + 3 months	09/18/2008	1,763		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	10/16/2008	1,791		28
Edit Delete	Notice of Allowance	12/11/2008	1,847		
Edit Delete	Issue Fee Paid	03/10/2009	1,936		
	Issue Fee Paid + 4 months	07/10/2009	2,058		
Edit Delete	Patent Grant Date	09/22/2009	2,132	74	
			Totals:	1,193	90
			PTA:	1,103	

